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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,289	09/16/2003	Katherine Woo	2043.140US1	4544
49845 7590 01/23/2009 SCHWEGMAN, LUNDBERG & WOESSNER/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
LASTRA, DANIEL				
ART UNIT		PAPER NUMBER		
3688				
NOTIFICATION DATE		DELIVERY MODE		
01/23/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM



### Office Action Summary

**Application No.**

10/664,289

**Applicant(s)**

WOO, KATHERINE

**Examiner**

DANIEL LASTRA

**Art Unit**

3688

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-7, 9-22, 25-27 and 29-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7, 9-22, 25-27 and 29-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



**DETAILED ACTION**

1. Claims 1, 4-7, 9-22, 25-27 and 29-43 have been examined. Application 10/664,289 (METHOD AND SYSTEM FOR OFFERING A MONEY-BACK GUARANTEE IN A NETWORK-BASED MARKETPLACE) has a filing date 09/16/2003.

**Response to Amendment**

2. In response to Non Final Rejection filed 07/21/2008, the Applicant filed an Amendment on 10/27/2008, which amended claims 1, 9, 22, 42, 43 and cancel claims 2, 3, 23 and 24.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 4-7, 9-22, 25-27 and 29-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. With respect to claims 1, 4-7 and 9-21, based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible



subject matter. Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials). Claims 22, 25-27, 29-41 are defined as system claims however, said claims are claiming only functional descriptive material (i.e. software) as "module" is defined in Applicant's specification as software. Claim 42 is not claiming a proper machine readable medium as Applicant's specification page 22 defines a "machine readable medium" as a carrier wave signals.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22, 25-27, 29-41 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 22, 25-27, 29-41 are indefinite because they are not system claims and claim 42 is indefinite because it is not claiming a proper computer readable medium.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.



Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-7, 9-18, 20-22, 25-27, 29-39 and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Junger (US 2004/0172260) in view of Lee (US 2004/0117383).

Claims 1, 22, 42 and 43, Junger teaches:

A method of providing a money-back guarantee for a transaction in a network-based marketplace, the method including:

providing a seller eligible to offer a buyer the money-back guarantee an option to offer the buyer the money-back guarantee (see paragraph 30);

receiving, over a network, a reimbursement request against the money-back guarantee for the eligible transaction (see paragraph 183);

responsive to receiving the reimbursement request, verifying the reimbursement request is eligible for the money-back guarantee (see paragraph 183); and

electronically reimbursing a buyer a predetermined amount associated with the eligible transaction and the money-back guarantee (see paragraph 184).

Junger does not expressly mention determining that a seller is eligible to offer a buyer the money-back guarantee. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the reason that the registration center in Junger monitors retailers return for possible problems or abuse (see Junger paragraph 90) is to determine if a retailer is eligible to participate in the system, such that fraudulent retailers would not be allowed to participate in the product's return system.



Junger does not teach providing a guarantee interface for the buyer to activate the money-back guarantee associated with the eligible transaction. However, Lee teaches that it is old and well known in the promotion art to purchase online extended warranties (see Lee co 15, claim 9). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Junger would allow customers to purchase online products from a e-tailer (see Junger paragraph 20) and to purchase online an extended warranty for said products, as taught by Lee in order to allow said customers to purchase a money-back guarantee for said products.

Claims 4 and 25, Junger teaches:

providing a seller interface for the seller to choose whether the money-back guarantee is offered on the eligible transaction (see paragraph 183) .

Claim 5, Junger teaches:

verifying that the eligible transaction is eligible for the money-back guarantee (see paragraph 183).

Claims 6 and 26, Junger teaches:

wherein the verifying includes determining that a transaction amount associated with the eligible transaction does not exceed a predetermined threshold (see paragraph 183).

Claims 7 and 27, Junger teaches:

wherein the verifying includes determining that a transaction occurred within a predetermined timeframe (see paragraph 123).



Claims 9 and 29, Junger teaches:

collecting a fee from the buyer for activating the money-back guarantee, wherein the fee is in addition to the associated transaction cost (see paragraph 24 “restocking fee”).

Claims 10 and 30, Junger teaches:

calculating the fee base upon a predetermined percentage of the transaction amount plus a flat fee (see paragraph 24 “restocking fee”).

Claims 11 and 31, Junger teaches:

receiving payment from the buyer for the money-back guarantee and the associated transaction cost and responsive to receiving the payment, generating a transaction identification number (see paragraph 28).

Claims 12 and 32, Junger teaches:

providing a reimbursement request interface for the buyer to submit the reimbursement request against the money- back guarantee associated with the eligible transaction (see paragraph 30).

Claims 13, 33 and 38, Junger teaches:

wherein the reimbursement request includes a transaction number, date of transaction, reason for the request, and type of item associated with the request (see paragraphs 30-31).

Claims 14 and 34, Junger teaches:



wherein the verifying of the reimbursement request includes verifying the eligibility of the transaction and seller for the money-back guarantee and verifying the buyer paid for the money-back guarantee (see paragraph 178).

Claims 15 and 35, Junger teaches:

reimbursing the buyer if an item associated with the eligible transaction is alleged to be defective (see paragraph 184).

Claims 16 and 36, Junger teaches:

reimbursing the buyer if an item associated with the eligible transaction is not received by the buyer (see paragraph 183).

Claims 17 and 37, Junger teaches:

reimbursing the buyer if an item associated with the eligible transaction is unwanted (see paragraph 183).

Claims 18 and 39, Junger teaches:

wherein the eligible transaction is an online transaction using the Internet (see paragraph 177).

Claims 20 and 41, Junger teaches:

wherein the online transaction is a fixed price transaction (see paragraph 184).

Claim 21, Junger teaches:

wherein the network-based marketplace supports transactions between a plurality of sellers and a plurality of buyers (see paragraph 183).

Claim 38, Junger teaches:



Wherein the network based marketplace supports transactions between a plurality of sellers and a plurality of buyers (see paragraph 28).

6. Claims 19 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Junger (US 2004/0172260) in view of Lee (US 2004/0117383) and further in view of Harrison (US 2001/0039524).

Claims 19 and 40, Junger fails to teach wherein the online transaction is associated with an online auction. However, Harrison teaches an online auction where seller can refund buyers for auction products (see paragraphs 133-134). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Junger and Lee refund system would be applied to online auctions, as it is old and well known in the art to request refunds in online auctions, as taught by Harrison.

#### ***Response to Arguments***

7. Applicant's arguments filed 10/27/2008 have been fully considered but they are not persuasive. The Applicant argues that the Junger does not teach "determining that a seller is eligible to offer a buyer the money-back guarantee". The Examiner answers that it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the reason that the registration center in Junger monitors retailers return for possible problems or abuse (see Junger paragraph 90) is to determine if a retailer is eligible to participate in the system, such that fraudulent retailers would not be allowed to participate in the product's return system.



***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Examiner, Art Unit 3688  
January 17, 2009